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10/611,383	06/30/2003	Anita Hogans Simpson	030150 (BLL-0099)	1519
36192	7590	10/31/2008	EXAMINER	
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/611,383

**Applicant(s)**

SIMPSON, ANITA HOGANS

**Examiner**

Marisol Figueroa

**Art Unit**

2617

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 11 August 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-30 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 30 June 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-8508)
- Paper No(s)/Mail Date \_\_\_\_\_

- 4) ☐ Interview Summary (PTO-413)
- Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(c), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 08/11/2008 has been entered.

### ***Response to Arguments***

2. Applicant's arguments with respect to claims 1-30 have been considered but are moot in view of the new ground(s) of rejection (Marutiak - US Patent No. US 5,568,546). See rejection below.

### ***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. **Claims 1-4, 7-11, 15-18, 21, 22, 24, and 25 are** rejected under 35 U.S.C. 103(a) as being unpatentable over PETERS et al. (US 2003/0003926 A1) in views of McBRIDE et al. (US 2002/0114431 A1) and MARUTIAK (US 5,568,546).

**With respect to claims 1, 21, 22, and 26,** Peters discloses a method (wireless telephone, system, and computer apparatus) for providing selected status announcements from a wireless telephone user to a caller, said method comprising:

receiving an incoming telephone call from a caller; responsive to a determination that an automatic answering mode applies to the incoming call; receiving a pre-selected announcement action corresponding to said incoming telephone call; and performing said pre-selected announcement action wherein if said pre-selected announcement action includes a hold announcement then answering said incoming telephone call by providing the caller with the hold announcement (Abstract; paragraphs [007], [0031]-[0033]; the wireless telephone receives an incoming call and then determines whether the user has placed the phone in automatic call answering mode, then the phone answers the incoming call by providing the calling party with a pre-recorded message (i.e., pre-selected announcement) indicating that the user will take the call momentarily and instructing the calling party not to hang-up (i.e., hold announcement)), wherein the hold announcement is selected from a list (paragraph [0033]; several messages may be available (i.e., list of messages) for selection by a user).

But, Peters does not particularly disclose wherein the list is sorted based on frequency of use.

However, Marutiak teaches the features of sorting a list based on frequency of use (Abstract, lines 1-12; col. 1, lines 40-55; a telephone terminal maintain a list of dialed telephone numbers and the list is sorted such that the most frequently used telephone numbers will be displayed at the top). Therefore, it would have been obvious to a person having ordinary skill in the art at the time of the invention, to modify Peters to include the

features of sorting the list of messages based on frequency of use, as suggested by Marutiak, since such a modification would facilitate the selection of a message from a list given that the most frequently used messages are displayed on top.

In addition, Peters discloses responsive to a determination that a manual answering mode applies to the incoming call: receiving a user-selected announcement action selected by said user from a list of announcement actions, said user-selected announcement action selected in response to receiving said incoming telephone call; and performing said user-selected announcement action including: if said user-selected announcement action includes said hold announcement then answering said incoming telephone call by providing the caller with the hold announcement; and if said user-selected announcement action includes a call-back announcement, then providing the caller with the call-back announcement and disconnecting the telephone call (paragraph [0041]);

and responsive to a particular caller identification associated with a particular caller, sending the incoming call to a voice mail system (paragraph [0034] lines 9-10; if the caller ID reveals a non-urgent call, the user can allow a voice mail system to answer the call).

But, Peters does not particularly disclose wherein the incoming call is sent to a voice mail system without alerting the user of the incoming call.

However, McBride teaches sending an incoming call to a voice mail system without alerting the user of the incoming call (Abstract; paragraphs [0019]-[0022]; unwanted calls based on their caller ID are sent to a Voice Mail system without causing the phone to ring). Therefore, it would have been obvious to a person having ordinary

skill in the art at the time of the invention, to modify Peters to include the features of sending an incoming call to a voice mail system without alerting the user of the incoming call, as suggested by McBride, since such a modification would prevent disturbing a user when receiving unwanted calls.

**With respect to claim 2**, the combination of Peters, Marutiak, and McBride disclose the method of claim 1, in addition Peters discloses wherein said answering said incoming telephone call by providing the caller with the hold announcement further includes placing the wireless telephone in mute mode until the user has taken the incoming telephone call (Fig. 5 – step 510; Abstract, lines 11-end; paragraph [0007]; the phone places itself into mute mode).

**With respect to claim 3**, the combination of Peters, Marutiak, and McBride disclose the method of claim 1, in addition Peters discloses further comprising notifying said user of said incoming telephone call (Fig. 4-step 404; paragraph [0040] lines 1-9).

**With respect to claim 4**, the combination of Peters, Marutiak, and McBride disclose the method of claim 3, in addition Peters discloses wherein said notifying includes one or more of an audible noise, a vibration, and a light (paragraph [0040] lines 1-9).

**With respect to claim 7**, the combination of Peters, Marutiak, and McBride disclose the method of claim 1, in addition Peters discloses wherein input to said determination that an automatic answering mode applies to the incoming call includes a Caller ID associated with said caller (paragraph [0032]-[0034]; the user may select an automatic answer mode based on the identity of the caller).

**With respect to claim 8**, the combination of Peters, Marutiak, and McBride disclose the method of claim 1, in addition Peters discloses wherein input to said determination that an automatic mode applies to the incoming call includes a time of day associated with said telephone call (paragraph [0032]-[0033]; the phone may select a prerecorded message based on the time of the day).

**With respect to claim 9**, the combination of Peters, Marutiak, and McBride disclose the method of claim 1, in addition Peters discloses wherein input to said determination that an automatic answering mode applies to the incoming call includes an instruction from said user (paragraph [0034]).

**With respect to claim 10**, the combination of Peters, Marutiak, and McBride disclose the method of claim 1, in addition Peters discloses wherein input to said determination that a manual mode applies to the incoming call includes one or more of a Caller ID associated with said caller, a time of day associated with said telephone call and an instruction from said user (paragraph [0041]).

**With respect to claim 11**, the combination of Peters, Marutiak, and McBride disclose the method of claim 1, in addition Peters discloses wherein said pre-selected announcement action includes a hold announcement (paragraph [0007]; in automatic answering mode, the phone answers the incoming call by providing the calling party with a message indicating that the user will take the call momentarily and instructing the calling party not to hang-up (i.e., hold announcement)).

**With respect to claim 15**, the combination of Peters, Marutiak, and McBride disclose the method of claim 1, in addition Peters discloses wherein said pre-selected announcement action is created by said user (paragraph [0033]).

**With respect to claim 16**, the combination of Peters, Marutiak, and McBride disclose the method of claim 1, in addition Peters discloses wherein said hold announcement includes an indication that said user will take said call momentarily (paragraph [0007]; in automatic answering mode, the phone answers the incoming call by providing the calling party with a message indicating that the user will take the call momentarily).

**With respect to claim 17**, the combination of Peters, Marutiak, and McBride disclose the method of claim 1, in addition Peters discloses wherein said hold announcement is pre-selected from a plurality of said hold announcements (paragraph [0033]; several messages are available on the phone and a particular message is selected).

**With respect to claim 18**, the combination of Peters, Marutiak, and McBride disclose the method of claim 1, in addition Peters discloses wherein said call-back announcement is pre-selected from a plurality of said call-back announcements (paragraph [0033]; several messages are available on the phone and a particular message is selected).

**With respect to claim 24**, the combination of Peters, Marutiak, and McBride disclose the system of claim 22, in addition Peters discloses wherein said network is a public switched telephone network (paragraph [0014]).

**With respect to claim 25**, the combination of Peters, Marutiak, and McBride disclose the system of claim 22, in addition Peters discloses wherein said network is an internet protocol network (paragraph [0014]).



5. **Claims 5, 6 and 12** are rejected under 35 U.S.C. 103(a) as being unpatentable over PETERS et al. in views of McBRIDE et al., MARUTIAK, and RUTLEDGE et al. (US 2002/0142756 A1).

**With respect to claims 5-6**, the combination of Peters, Marutiak, and McBride disclose the method of claim 1, but the combination does not particularly disclose further comprising reminding said user that said caller is on hold in response to said user providing the caller with the hold announcement, and wherein said reminding said user that said caller is on hold includes one or more of an audible noise, a vibration, and a light.

However, Rutledge teaches a telephone answering system that allows the user of a phone to provide a caller with a hold announcement and reminding said user that said caller is on hold, wherein said reminding said user that said caller is on hold includes one or more of an audible noise, a vibration, and a light (paragraphs [0019]-[0020] and [0025]; the user of the phone presses a button that sends a message to the caller instructing the caller to hold the line and the call will be picked up shortly, and the phone provides a light or other alert means to remind the recipient of the holding call). Therefore, it would have been obvious to a person having ordinary skill in the art at the time of the invention, to modify the combination to include further comprising reminding said user that said caller is on hold in response to said user providing the caller with the hold announcement, and wherein said reminding said user that said caller is on hold includes one or more of an audible noise, a vibration, and a light, as suggested by Rutledge, to prevent the recipient from inadvertently forget about the caller in hold.

Art Unit: 2617

**With respect to claim 12**, the combination of Peters, Marutiak, and McBride disclose the method of claim 1, but the combination does not particularly disclose wherein said pre-selected action includes a call-back announcement.

However, Rutledge teaches a telephone answering system that includes call-back announcements (Abstract; paragraphs [0024]-[0025]; the system allows a recipient of a phone call to select a desired greeting informing the caller that the call cannot be taken at this time and providing an indication of when to expect a return call, such as: "I'm sorry, I can't pick up the phone right now, but please leave your number and I'll call back in ((n-10x10) minutes)"). Therefore, it would have been obvious to a person having ordinary skill in the art at the time of the invention, to modify the combination to include call back announcements, as suggested by Rutledge, in order to inform the caller that the call cannot be taken at the time but to expect a call from the recipient at a later time.

6. **Claims 13, 14, 19, 20, and 23** are rejected under 35 U.S.C. 103(a) as being unpatentable over PETERS et al. in views of McBRIDE et al., MARUTIAK, and BREMER (US 6,018,671).

**With respect to claims 13-14**, the combination of Peters, Marutiak, and McBride disclose the method of claim 1, but the combination does not particularly disclose wherein said pre-selected announcement action includes a voice mail announcement and wherein said performing said pre-selected announcement action includes providing said caller with a recorded announcement and directing said call to said voice mail system.

However, Bremer teaches a wireless telephone that plays pre-recorded reply messages/announcements to a calling party including a voice mail announcement and announcement directing said call to said voice mail system (Abstract; col. 3, line 60-col.

4, lines 1-4; the recipient of the incoming call can reply with pre-recorded reply messages telling the caller that the called party can not answer soon, but the caller can leave a message and/or a message giving the caller the option to forward the call to a network voice mail system). Therefore, it would have been obvious to a person having ordinary skill in the art at the time of the invention to modify the combination to include a voice mail announcement and a recorded announcement directing said call to a voice mail system, as suggested by Bremer, to inform the caller that the called party is unavailable or can not answer soon, but the caller can leave a message.

**With respect to claims 19-20**, the combination of Peters, Marutiak, and McBride disclose the method of claim 1, but the combination does not particularly disclose wherein said performing said user-selected announcement action further includes if said user-selected announcement action includes a voice mail announcement, then directing said call to said voice mail system including specifying said voice mail announcement; and wherein said performing said user-selected announcement action further includes if said user-selected announcement action includes a voice mail announcement, then providing said caller with a recorded announcement and directing said call to said voice mail system.

However, Bremer teaches a wireless telephone that plays pre-recorded reply messages/announcements to a calling party including a voice mail announcement and announcement directing said call to said voice mail system (Abstract; col. 3, line 60-col. 4, lines 1-4; the recipient of the incoming call can reply with pre-recorded reply messages telling the caller that the called party can not answer soon, but the caller can leave a message and/or a message giving the caller the option to forward the call to a network

Art Unit: 2617

voice mail system). Therefore, it would have been obvious to a person having ordinary skill in the art at the time of the invention to modify the combination to include a voice mail announcement and a recorded announcement directing said call to a voice mail system, as suggested by Bremer, to inform the caller that the called party is unavailable or can not answer soon, but the caller can leave a message.

**With respect to claim 23**, the combination of Peters, Marutiak, and McBride disclose the system of claim 22, but the combination does not particularly disclose wherein said performing said pre-selected announcement action further includes if said user-selected announcement action includes a voice mail announcement, then directing said call to said voice mail system.

However, Bremer teaches a wireless telephone that plays pre-recorded reply messages/announcements to a calling party including a voice mail announcement and directing said call to said voice mail system (Abstract; col. 3, line 60-col. 4, lines 1-4; the recipient of the incoming call can reply with pre-recorded reply messages telling the caller that the called party can not answer soon, but the caller can leave a message and/or a message giving the caller the option to forward the call to a network voice mail system). Therefore, it would have been obvious to a person having ordinary skill in the art at the time of the invention to modify the combination to include wherein said performing said pre-selected announcement action further includes if said user-selected announcement action includes a voice mail announcement, then directing said call to said voice mail system, as suggested by Bremer, to inform the caller that the called party is unavailable or can not answer soon, but the caller can leave a message.

Art Unit: 2617

7. **Claims 13, 14, 19, 20, and 23** are rejected under 35 U.S.C. 103(a) as being unpatentable over PETERS et al. in views of McBRIDE et al., MARUTIAK, and BROWN et al. (US 7,010,288 B2).

**With respect to claims 27-30**, the combination of Peters, Marutiak, and McBride disclose the method (wireless telephone, system, and computer apparatus) of claims 1, 21, 22, and 26, but the combination does not particularly disclose wherein the automatic answering mode includes a list of tailored announcements that cover user specific situations and each of the announcements is named.

However, Brown teaches an automatic answering system that includes a list of tailored that cover user specific situations and each of the announcements is named (Fig. 7; col. 7, line 25 – col. 8, lines 1-18). Therefore, it would have been obvious to a person having ordinary skill in the art at the time of the invention, to modify the combination to include a list of tailored announcements that cover user specific situations, as suggested by Brown, since such a modification would allow the selection of an answering message depending on the activity of the user, thus, providing a more flexible solution than voice mail systems.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marisol Figueroa whose telephone number is (571) 272-7840. The examiner can normally be reached on Monday Thru Friday 8:30 a.m. - 5:00 p.m.

Art Unit: 2617

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent P. Harper can be reached on (571) 272-7605. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/VINCENT P. HARPER/

Supervisory Patent Examiner, Art Unit 2617

/Marisol Figueroa/

Examiner, Art Unit 2617